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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,585	11/20/2001	Kazuhiko Horikoshi	566.40894X00	8920

20457 7590 02/27/2003

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ARLINGTON, VA 22209

EXAMINER

TRAN, THIEN F

ART UNIT	PAPER NUMBER
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2811

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,585

Applicant(s)

HORIKOSHI ET AL.

Examiner

Thien F Tran

Art Unit

2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,9,11 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,9,11 and 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamazaki et al. (US 6,025,630).

Yamazaki et al. discloses the claimed thin-film transistor (Fig. 2E) comprising a glass substrate (Corning 7059) 201; and formed at an upper part of said glass substrate, a channel region 208, a source region 206, a drain region 207 and an insulating layer 204, wherein said channel region, said source region and said drain region comprise non-monocrystalline silicon (polycrystalline silicon) formed by excimer laser method (col. 2, lines 27-35; col. 6, lines 50-60 of Yamazaki), said glass substrate 201 has the same material used by applicant for the claimed substrate (an annealed glass substrate CORNING 7059 in the final structure), and said insulating layer 204 covers said channel region.

Regarding claim 11, said insulating layer is a silicon oxide layer.

The claim limitations "said glass substrate is such that its compaction is 30 ppm or higher, when said glass substrate is heated at 600⁰ C for 1 hour and thereafter cooled at a rate of 1⁰ C/minute" in claim 9 and "formed by oxidizing a surface of said channel region at a temperature of 500⁰ C or below" in claim 11 are taken to be product by

Art Unit: 2811

process limitations which carry no weight in claims drawn to structure. A product by process claim directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See In re Fessman, 180 USPQ 324, 326 (CCPA 1974); In re Marosi et al., 218 USPQ 289, 292 (Fed. Cir. 1983); and particularly In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process steps, which must be determined in a "product by process" claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old and obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

Claims 1, 2 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al. (JP 8-195494).

Abe et al. discloses the claimed thin-film transistor (Fig. 2) comprising a high heat resisting glass substrate (Corning 7059) 1; and formed at an upper part of said glass substrate, a channel region 2, a source region (2, 7), a drain region (2, 7), a first insulating layer 3 and a second insulating layer 4, wherein said channel region, said source region and said drain region comprise polycrystalline silicon, said glass substrate 1 has the same material used by applicant for the claimed substrate (an annealed glass substrate CORNING 7059 in the final structure), said first insulating layer 3 covers said channel region, and said second insulating layer is formed on a surface of said first insulating layer.

Regarding claim 2, Abe et al. discloses said first insulating layer 3 has a layer thickness of 5 to 10 nm which is in the claimed range, 4 nm or larger or at least 4 nm.

Regarding claim 22, said first insulating layer 3 is a silicon oxide layer.

The claim limitation "said glass substrate is such that its compaction is 30 ppm or higher, when said glass substrate is heated at 600⁰ C for 1 hour and thereafter cooled at a rate of 1⁰ C/minute" in claim 1 is taken to be a product by process limitation which carries no weight in claims drawn to structure. A product by process claim directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See In re Fessman, 180 USPQ 324, 326 (CCPA 1974); In re Marosi et al., 218 USPQ 289, 292 (Fed. Cir. 1983); and particularly In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985), all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process steps, which must be determined in a "product by process" claim, and not the patentability of the process. See also MPEP 2113. Moreover, an old and obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 9, 11 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2811

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien F Tran whose telephone number is (703) 308-4108. The examiner can normally be reached on 8:30AM - 5:00PM Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 09/988,585

Page 6

Art Unit: 2811

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February 25, 2003

A handwritten signature in black ink, appearing to read "Thien Tran".

Thien Tran
Patent Examiner
Technology Center 2800